

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No. 09/202,216

Q52648

REMARKS

Upon entry of the Amendment, Claims 1-4, 6-7 and 9-16 are all the claims pending in the application. Claim 5 is canceled.

Reconsideration and review of the claims on the merits are respectfully requested.

Formal Matters

Applicants appreciate that the Examiner has acknowledged Applicants' claim for foreign priority, and further confirmed receipt of the certified copy of the priority document. Also, Applicants request the Examiner to return initialed Form PTO/SB/08 A & B (modified) for the Information Disclosure Statement filed February 4, 2004.

Double Patenting Rejection

Claims 1-7 and 9-15 are rejected under the judicially created doctrine of obviousness-type double patenting over patents to Atarashi et al, specifically claims 1-6 of U.S. Patent No. 5,985,466, AND claims 1-13 of U.S. Patent No. 6,310,118, AND claims 1-20 of U.S. Patent No. 5,763,085, AND claims 1-3 of U.S. Patent No. 6,207,280 for the reasons given in the Office Action. The Examiner states that the present claims, if allowed, would improperly extend the "right to exclude" already granted in the patent

The Examiner asserts that although the conflicting claims are not identical, they are not patentably distinct from each other, stating that each of the cited patents and the application claim a multi-layer coated powder, wherein the coatings comprise metal oxides.

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Specifically, for example, regarding U.S. Patent No. 5,985,466 to Atarashi et al, the Examiner asserts that the claims (in U.S. '466) are broader than the claims of the instant application in not requiring a specific gravity, and are therefore anticipated by the claims of the application.

Applicants respectfully traverse the rejection.

The claimed specific gravity range is critical to achieve the present invention and such subject matter patentably distinguishes over the claims of the reference patent.

The base particle of the present invention must have a specific gravity from 0.1 to 10.5, which constitutes the base of the multilayer-coated powder. The specific gravity of this base is preferably from 0.1 to 5.5, more preferably from 0.1 to 2.8, from the standpoints of flowability and suspensibility. If the base has a specific gravity below 0.1, the buoyancy of the base is so large that the film should be made to comprise a larger number of layers or to be exceedingly thick, which is uneconomical. On the other hand, if the base has a specific gravity exceeding 10.5, a thick film for suspending the base is necessary, which also is uneconomical. In addition, in the case of cosmetics and the like, such a powder having too large a particle diameter is unsuitable because it gives a sandy feeling (See page 7, first full paragraph).

The Examiner's comment that the patented claims are broader than the claims of the present application pertains to an alternate basis for the obviousness-type double patenting rejection, namely, improperly extending the "right to exclude" already granted in previous patents. The Examiner's reasoning is that, for example, a third party practicing the invention of present claim 1 would necessarily also infringe claim 1 of U.S. '466. However, that is not

necessarily the case, because the metal oxide film may be formed other than by hydrolyzing a metal alkoxide as provided in claim 1 of the '466 patent.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the double patenting rejection.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner states that our previous arguments with respect to the claims have been considered but are moot in view of the new ground of rejection.

Claims 1-7 and 9-15 are rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over U.S. Patent 5,061,317 to Korpi et al for the reasons given in the Office Action.

The Examiner cited Korpi et al as disclosing a nacreous (i.e., having the lustre of mother-of-pearl) pigment and a method for its preparation. The Examiner acknowledged that Korpi does not disclose the particular specific gravity of the base particle, or the interference peak or bottom of each coating layer. The Examiner considered that absent evidence to the contrary, the burden is upon the Applicants to prove that there is an unobvious difference between the claimed products and the prior art products.

Applicants respond as follows.

Applicants incorporate the subject matter of Claim 5 into Claim 1, and cancel Claim 5, in order to clarify that at least one of the coating layers is an organic layer. In this regard, conventional applications do not teach or suggest the use of organic substances in a layer. As shown in Example 4 of the present specification, a powder containing a resin layer is the powder

colored in green. Moreover, the specific gravity of the above powder was low, and dispersibility and flowability in a liquid were improved. New claim 16 depending from claim 1 further characterizes the organic layer as comprising a resin.

The powder of the present invention is not a powder formed by oxide films alone (such as that disclosed in Korpi et al), but a pigment powder for a cosmetic containing an organic layer (e.g., a resin layer). Because of this difference, dispersibility and flowability of the powder of the present invention in a liquid are excellent, thus lending to its suitability as a pigment powder for a cosmetic. Importantly, Korpi et al directed to a nacreous pigment based on metal-oxide-coated mica particles or on other layer silicate particles does not meet all of the limitations of amended claim 1 which requires that at least one of the coating layers is an organic layer. Moreover, the Examiner has not cited any prior art which would teach or suggest the desirability of modifying the nacreous pigment of Korpi et al to include an organic layer as claimed.

Therefore, Applicants submit that Claims 1-4, 6-7 and 9-16 are not rendered obvious by Korpi et al.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

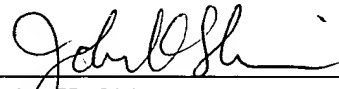
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